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Paper No. 7

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In re Application of
Kubota, et al.
Application No. 09/678,953
Filed: October 3, 2000
Attorney Docket No. 113918,401

SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS
DECISION DISMISSING
PETITION

This is a decision on the petition under 37 C.F.R. §§1.182 and 1.183, filed April 16, 2001, requesting that the above-identified application be accorded a filing date of October 2, 2000, rather than the presently accorded filing date of October 3, 2000. Petitioner seeks waiver of the requirements of 37 C.F.R. §1.10, because patent rights could be lost or jeopardized by losing the October 2, 2000 filing date, in that, the priority date of the provisional application could be lost.

Consideration under §1.182

Preliminarily, petitioner's request under §1.182¹ to reconsider the decision declining to consider this application on petition filed December 20, 2000, must be considered. Applicant filed the petition formatted as "a single petition for twelve separate applications" to accord a filing date of October 2, 2000, to each application. Pursuant to 37 CFR §1.4(b), the Office considered the petition on the merits only as to the first identifiable application, PCT/US00/27462 (Decision mailed March 15, 2001). As to the other applications, including the instant application, the Office directed applicant to file separate petitions.

Petitioner's argument is not persuasive. It is correct that no correspondence related to an application should be filed prior to receipt of the application number from the Office. See §1.5. Likewise, a petition to accord a filing date should be filed promptly upon becoming aware that the Office will be according the application an incorrect filing date. See §1.10; §1.181. Nonetheless, waiver of §1.4 is not warranted. By December 20, 2000, applicant had been made aware of this application's number, and within three months of the filing date had sufficient information to file a separate filing date petition. More importantly, the instant petition is considered promptly filed within the meaning of §§1.10 and 1.181, and thus, waiver of §1.4 is not necessary to achieve the relief requested. A request for waiver under §1.183 is being considered as the appropriate relief.

¹ §1.182 provides that

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, ...

Consideration under \$1.183

35 U.S.C. §21(a) provides that:

The Commissioner may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Commissioner.

By rules 6² and 10,³ the Commissioner has set forth the requirements for establishing the date of receipt and Express

² §1.6 Receipt of correspondence

(a) ... Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

...
(2) Correspondence filed in accordance with §§1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.

...
(c) ... In addition to being mailed, correspondence may be delivered by hand during hours the Office is open to receive correspondence.

³ §1.10 Filing of correspondence by "Express Mail."

(a) Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation.

...
(d) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

...
(3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

Mail date of deposit of correspondence in the Office, as reflected in the "Office Date" stamp. If an application includes the necessary components for a filing date (see 37 C.F.R. 1.53(b)-(d) and MPEP §506), the "Office Date" stamp establishes the "filing date."

37 C.F.R. §1.183 provides that "in an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed."

Petitioner acknowledges that the above-identified application was not deposited pursuant to the requirements of §1.6 on October 2, 2000, and was not deposited pursuant to the requirements of §1.10 until October 3, 2000. However, petitioner maintains that the application should nonetheless be deemed to have been deposited on October 2, 2000 because: 1) an extraordinary situation precluded petitioner's employee from hand-delivering the application to the Office by midnight of October 2, 2000; 2) petitioner then acted diligently to deposit the application into Express Mail on October 2, 2000; and 3) the application was physically within the Honolulu International Airport Express Mail drop box by 12:20 am on October 3, 2000, which was 11:20 pm on October 2, 2000, in another United States Postal Service office location -- i.e. American Samoa.

§1.183 does not allow the Office to consider an application deposited with the USPS on October 3, 2000, as one deposited on October 2, 2000. The requirement that a paper be considered filed in the Office on the date on which it was deposited with the USPS is a requirement of 35 U.S.C. §21(a), and cannot be waived. The fact that it was October 2, 2000, in a time zone other than the one in which the application was deposited is irrelevant. Accordingly, absent a showing that the application was deposited with the USPS on October 2, 2000, the petition under §1.183 must be **dismissed**.

Even if petitioner could show that the application was deposited with the USPS on October 2, 2000, but for other reasons was not afforded the benefit of a date of receipt under either §1.6 or §1.10, waiver is not warranted. It is acknowledged that if either rule 6 or rule 10 is not waived petitioner's application for patent will lose the right of priority under 35 U.S.C. §119(e)(1) to prior provisional application No. 60/157,052. The records of the Office show that the provisional application No. 60/157,052, was filed on October 1, 1999. Thus, the instant application must be accorded a filing date of no later than Monday, October 2, 2000⁴, to claim priority to this provisional application.

⁴ 35 U.S.C. §119(e)(3). If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

However, to justify waiver of the rules under 37 C.F.R. §1.183, it is not enough to show a great loss of rights if relief is not granted. An extraordinary situation justifying waiver of the rules must be shown. In this instance, the circumstances of the failure to deposit the application in compliance with rule 6 or to timely deposit the Express Mail package in compliance with rule 10 has not been shown to be an extraordinary situation that would justify a waiver of the rules.

Petitioner attributes the failure to hand-deliver the application to the Office by midnight of October 2, 2000, to a flare up of the medical condition of the employee charged with assisting in preparing the application and delivering the application. The circumstances of this failure to comply encompasses much more than a single employee's illness. Critical to this failure was petitioner's decision to wait until the last hours on the last day to file this application and claim priority to the provisional application. The attorney of record acknowledges that twelve applications, including the instant application, were "being put in final form throughout the day and evening of Monday, October 2, 2000," and that the employee charged to deposit the applications left "around 11:48 pm for her trip to the USPTO mail room." Petitioner has not shown that they "took detailed steps to ensure that the timely filing took place," and that due to unforeseeable circumstances were unable to comply with either rule 6 or rule 10. An applicant may delay action until the end of the time period for reply. In doing so, however, the applicant must assume the risk attendant to such delay. Ex parte Warren, 1901 Dec. Comm'r Pat. 137 (Comm'r Pat. 1901).

Likewise, no extraordinary circumstance has been shown to have occurred to have precluded the petitioner, as directed in rule 10(b), from depositing the correspondence directly with an employee of the USPS, or as directed in rule 10(d), from depositing the Express Mail in a box prior to the last scheduled pickup on October 2, 2000 (and maintaining corroborating evidence of the deposit). Petitioner has merely shown that after failing to comply, petitioner undertook extreme measures to transmit the application to a practitioner in Hawaii in an effort to get the application deposited prior to the last scheduled pickup "Hawaii" Time. This effort failed not due to extraordinary circumstances. Petitioner simply ran out of time prior to the last scheduled pickup of the day, at 8:30 pm that day.

Accordingly, on the merits, the petition under §1.183 must be **DISMISSED**.

Any request for reconsideration must be filed within **TWO (2) MONTHS** of the date of this decision in order to be considered timely. See 37 C.F.R. § 1.181(f). This time period may **not** be extended pursuant to 37 C.F.R. §1.136(a) or (b).

Further correspondence with respect to this matter should be addressed as follows:

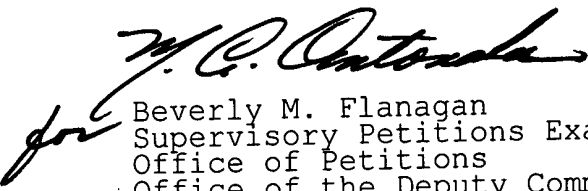
By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

The application is being returned to the Office of Initial Patent Examination for completion of pre-examination processing with the presently accorded filing date of October 3, 2000.

Telephone inquiries specific to this decision should be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.


for Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy